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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,153	09/21/2001	Cheryl Ann Moore	6509-1068	4680

7590

06/18/2003

LEE, MANN, SMITH, MCWILLIAMS SWEENEY & OHLSON  
P.O. BOX 2786  
CHICAGO, IL 60690-2786

EXAMINER

FAISON, VERONICA F

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/961,153

Applicant(s)

MOORE ET AL.

Examin r

Veronica F. Faison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 13 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Claim Objections***

Claims 4-6 and 8 are objected to because of the following informalities: Claims 4-6 and 8, all have the word preferably stated in the claim (i.e. preferably a smaller range or a particular component). The Examiner is not given any consideration to anything that follows the word preferably. The Examiner suggests that if Applicant wants these limitations to be considered, to delete the phrase (i.e. preferably from 2 to 20%, as disclosed in claim 4) and making this a separate dependent claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-12, 14-15, 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansukhani (US Patent 4,243,694).

Mansukhani teaches an ink composition suitable for ink jet printing on metal, plastic or paper surfaces wherein the ink comprises a resin component (binder), at least one solvent, and a fluorescent compound (abstract and col. 1 line 63-col. 2 line 3). The reference also teaches that addition components may be present such as drying, dispersing and wetting agents (col. 2 lines 3-6). The resin/polymer component is present in the amount of 1 to 80%, which may be used alone or in blends, which dissolve in the solvents. The solvents disclosed by the reference include ethyl alcohol (ethanol), acetone, and methyl acetate, which may be used in combination as seen in the examples (col. 2 lines 24-56). The reference remains silent to the amount of solvent present, however the examples show that the solvents are present in ranges that overlap Applicant's claimed range. The resin component may be synthetic, semi-synthetic and natural resins such as polyvinyl resins include polyvinyl butyral resin (which is shown in the examples) (col. 3 lines 4+). The reference discloses a process in the claims for information recording wherein the composition is applied to a recorded information (method of printing). Mansukhani discloses that the ink was used in the ink jet printing of indicia on the ends of aluminum cans and on tin-free steel cans, wherein the indicia dried very quickly to form images. The metal surfaces may be coated (treated with a release aid) to improve the properties of the ink composition (col. 2 line 60+). However the reference does not disclose the actual time that the indicia dries, therefore it would have been obvious that the compositions would have similar drying

times because they have similar ink compositions, absence evidence to the contrary. Mansukhani fails to specifically exemplify the use of methyl acetate as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the methyl acetate as claimed by applicant as Mansukhani also discloses the use of methyl acetate but shows no example incorporating them.

Claims 1-7, 10-12, 17-18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torii et al (US Patent 6,207,613).

Torii et al teach a reversible thermosensitive coloring composition comprising an electron donating coloring agent and an electron accepting color developer (abstract and col. 4 lines 39-41). The reference further teaches that the recording layer comprises a coloring agent, a color developer, a color formation/erasure controlling agent, a crosslinking resin (binder) and a solvent mixed. The resins disclosed by the reference include acrylic copolymers and carboxymethyl cellulose resins. The solvent that may be present in the composition includes ethanol, acetone and methyl acetate. Each component may be dispersed or dissolved in a solvent and then the dispersions and/or solutions may be mixed to prepare a coating liquid (col. 21 lines 19-62). The reference broadly discloses a process of making an ink composition, wherein the Applicant has a detailed process of making, however in general, the transposition of process steps or the splitting of one step into two, where the processes are substantially identical or equivalent in terms of function, manner and result, was held to be not patentably distinguish the processes. *Ex parte Rubin* 128 USPQ 440 (PTO BdPatApp 1959). The reference shows in the examples that the solvent may be used in

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combination. The undercoat layer, recording layer, intermediate layer, and protective layer may include a lubricant (release aid). The recording material may be any shape such as a sheet, card, roll, and may have a print layer thereon which may be formed by ink jet printing (col. 25 lines 6-12). Torii et al fail to specifically exemplify the use of methyl acetate as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the methyl acetate as claimed by applicant as Torii et al also discloses the use of methyl acetate but shows no example incorporating them.

#### ***Allowable Subject Matter***

Claim 20 is allowed.

Claim 13 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The references alone or in combination fail to teach the ink composition comprising a colorant, binder and a solvent which comprises methyl acetate printed onto a substrate which is based on a polymer selected from the group consisting of polymers of propylene, polymers of ethylene and polymers of propylene and ethylene or wherein the substrate is formed into a wrapping for a food product.

#### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica F. Faison whose telephone number is 703-


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305-3918. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Veronica F. Faison  
June 2, 2003

  
Mark L. Bell  
Supervisory Patent Examiner  
Technology Center 1700